

REMARKS

Upon entry of the present Reply, claims 1-26 will be pending, and claims 1, 8 and 10-26 will have been amended to further clarify the claimed subject matter.

Initially, the Applicants would like to thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f), as well as confirming receipt of the certified copy of the priority document.

Applicants also note with appreciation the Examiner's consideration of the documents cited in the Information Disclosure Statements filed on April 25, 2004 and July 22, 2004 in the present application. Applicants thank the Examiner for returning, with the afore-noted Office Action, initialed and signed copies of the PTO-1449 Forms that accompanied the April 25, 2004 and July 22, 2004 Information Disclosure Statements.

Applicants also note with appreciation the Examiner's consideration and acceptance of the drawings filed April 15, 2004.

In the above noted Official Action mailed May 4, 2006, the Examiner rejected claims 11, 12, 15, 16, 21, 22, 25 and 26 under 35 U.S.C. 102(b) as being anticipated by International Publication No. WO 01/65807 A2 to Anders Waesterlid ("WAESTERLID"). The Examiner further rejected claims 1-6, 8-10, 13, 14, 17-20, 23 and 24 under 35 U.S.C. 103(a) as unpatentable over WAESTERLID in view of U.S. Patent Application Publication No. US 2002/0168992 A1 to Niko Eiden *et al.* ("EIDEN"). The Examiner also rejected claim 7 under 35 U.S.C. 103(a) as unpatentable over WAESTERLID in view of EIDEN and in further view of U.S. Patent Application Publication No. US 2003/0070070 A1 to William J. Yeager *et al.* ("YEAGER"). Applicants respectfully

traverse all rejections and request that the Examiner reconsider the rejections, withdraw the same, and indicate the allowability of all pending claims, *i.e.* claims 1-26.

Applicants traverse the rejection of claims 11, 12, 15, 16, 21, 22, 25 and 26, under Section 102, as being anticipated by WAESTERLID. Applicants submit that WAESTERLID fails to disclose each and every feature of the present invention as recited in these claims.

Referring to Figures 6A, 6B, 7 and 8, for example, of WAESTERLID, the publication describes a mobile-to-mobile communication system with a server-centralized system for handling affinity group membership. At page 12 and Figures 6A and 6B of the publication, WAESTERLID describes a new member addition process in the communication system. The publication describes a process where a first user sends a message to a messaging server 170 (step 204, FIG. 6A) in order to relay a message to one or more prospective members (step 208, FIG. 6A), whom the first member would like to join an affinity group. WAESTERLID specifies that “[o]nly the group administrator can send a Membership Request message.” See WAESTERLID, page 12, lines 28-29. The Request for Membership message transmitted to the prospective member is illustrated at page 17 of the publication, in Appendix A. Should the prospective member accept membership (step 212, FIG. 6A) by transmitting a Membership Reply Message (page 17, Appendix A), then the prospective member would be added as a new member to a group database (step 216, FIG. 6B) in the server 170. In addition, the new member’s client application will create an affinity group database stored it in a memory of the client device, including a record for each member of the affinity group. The server 170 relays the new member’s acceptance to the group administrator. A Group Update message is then sent to all members (step 220, FIG.

6B) from server 170. The Group Update message may be generated in either the server 170 or the group administrator's communication device 100, but in either case, the Group Update message containing a list of all members of the group is transmitted from the server 170. This differs from Applicants' claimed invention, in which member information is extracted from received mail from existing members, and used to assemble a member list in a newly joined member's terminal device.

WAESTERLID describes a member resignation process in FIG. 7, as well as the corresponding text at page 14 of the publication. The member resignation process, like the member addition process requires centralized control and updating by server 170. In the WAESTERLID publication, if an existing member wishes to resign from an affinity group, the member sends a Resignation message to the messaging server 170 (step 302, FIG. 7). Upon receiving the Resignation message, the server forwards the Resignation message to the group administrator (step 304, FIG. 7) and removes the resigning member from the group database (step 306, FIG. 7). The group administrator, or server, then generates a Group Update message, which is transmitted to all members, to delete the resigning member (step 308, FIG. 7). The Group Update message contains a list of all members, with the exclusion of the resigning member (see e.g. page 14, lines 3-4 and Appendix A). Applicants submit that this also differs from the present invention, as defined by the amended claims.

WAESTERLID discloses that a server-centralized system is employed to update member communication devices by transmitting a Group Update list, including a list of all members to a given affinity group, to communication devices 100 of existing members. The Update message contains a complete list of all members of the group. See e.g. page 14, lines 1-5.

On the other hand, each of independent claims 11, 15, 21, and 25 of the present application recites that an entry in a member list is generated from member information extracted from received contact mail from an existing member. Applicant submits that WAESTERLID does not teach (or even suggest) generating a member list in a terminal device based on member information extracted from received contact, *i.e.* contact mail received from other existing member terminal devices. Thus, Applicants submit that claims 11, 15, 21 and 25 are patentable over the applied art for at least the above discussed reasons, and respectfully request that the Examiner withdrawal the rejection of these claims and indicate their allowability.

Applicants further submit that WAESTERLID fails to anticipate at least the member withdrawal features recited in independent claims 12, 16, 22 and 26. For example, independent claim 12 recites “a member information deleter that deletes member information of all members from said member information storage belonging to the group in response to the withdrawal mail transmitter transmitting the withdrawal mail”. As a further example, claims 16, 22 and 26 each recite “deleting member information of all members from said member information storage belonging to the group in response to the communications device transmitting the withdrawal mail.” Applicants submit that WAESTERLID does not disclose the deletion of all member information of members belonging to the group that the terminal is withdrawing from, as recited in claim 12, 16, 22 and 26.

Applicants submit that in WAESTERLID does not teach that a resigning member transmits a withdrawal mail from the resigning member's communications device 100 to other communications devices 100 directly. Instead, Applicants submit that the resigning member in WAESTERLID sends a resignation message to server 170 (step

302, FIG. 7), which then relays a message to the group administrator (step 304, FIG. 7), who then, in turn, removes the resigning member from the member database (step 306, FIG. 7) and causes the server to send a Group Update message (step 308, FIG. 7) to all other members. WAESTERLID does not teach (or even suggest) deleting all group members from the resigning member's communications device. Thus, Applicants submit that claims 12, 16, 22 and 26 are patentable over the applied art and respectfully request that the Examiner withdraw the above rejection and indicate these claims to be allowable.

Regarding claims 1-6, 8-10, 13, 14, 17-20, 23 and 24, Applicants respectfully submit that the cited publication to EIDEN does not make up for the deficiencies of WAESTERLID discussed above. Applicants respectfully traverse the rejection of claims 1-6, 8-10, 13, 14, 17-20, 23 and 24 over WAESTERLID and EIDEN for at least the reasons discussed below.

In the above noted Official Action, the Examiner has conceded that WAESTERLID fails to disclose that the group member and current members extract newly joined member information. The Examiner relies on EIDEN to fill the deficiencies found in WAESTERLID. However, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine WAESTERLID and EIDEN, and, if such a combination were to be possible, *arguendo* (and the Applicants submit that it would not), the combination would still fail to teach or suggest, alone or in any proper combination, the claimed subject matter of claims 1-26, and particularly claims 1-6, 8-10, 13, 14, 17-20, 23 and 24.

As discussed above, WAESTERLID is directed to a centralized communications system with a server 170 and group administrator at the center, controlling all facets of

membership. Meanwhile, EIDEN is directed to a peer-to-peer system wherein membership is controlled by majority vote. WAESTERLID's hierarchical architecture and a teaching requiring that "only the group administrator can send a Membership Request message" (WAESTERLID, page 12, lines 28-29), teaches away from EIDEN's peer-to-peer system where control over membership is distributed amongst the group members. Thus, Applicants submit that one of ordinary skill in the art would not have been motivated at the time of Applicants' invention to combine WAESTERLID and EIDEN to arrive at the instant invention.

Assuming *arguendo* that a combination were possible between the WAESTERLID and EIDEN teachings (Applicants submit such a combination would not have been possible because it would have destroyed the WAESTERLID system), the combination would still fail to teach or suggest the recitations of claims 1-6, 8-10, 13, 14, 17-20, 23 and 24. For example, each of these claims recites the feature of generating or storing an entry in a member list stored in a mail exchange terminal by extracting member information from a received mail from another terminal.

To the contrary, Applicants submit that WAESTERLID and EIDEN do not teach or suggest, alone or in any proper combination, the noted recitation. Instead of recording an entry in a member list using information extracted from mail received from another terminal, WAESTERLID and EIDEN teach transmitting an entire member list to mail exchange terminals. WAESTERLID transmits the Membership Reply and Group Update Messages shown in Appendix A at page 17 from a centralized server 170 to all communication devices 100. EIDEN transmits "information comprising for instance . . . such as name, address and other contact information of the members" (see paragraph 29, EIDEN) from an existing member to a new member who has requested the

information (step 213, FIG. 2, EIDEN). Thus, even if the references were combined, *i.e.* against their respective teachings, the combination would teach transmitting entire member lists to terminals, thus still failing to teach or suggest generating or storing an entry in a member information storage or list using member information extracted from a received mail from another mail exchange terminal as recited in Applicants' claims 1-6, 8-10, 13, 14, 17-20, 23 and 24. Thus, Applicants respectfully request that the Examiner withdraw the outstanding rejection and indicate the allowability of claims 1-6, 8-10, 13, 14, 17-20, 23 and 24, in addition to above-noted claims 11, 12, 15, 16, 21, 22, 25 and 26, which Applicants submit are patentably distinguished above over the applied art.

As noted earlier, the Examiner also rejected claim 7 as being unpatentable under Section 103 over the combination of WAESTERLID, EIDEN and YEAGER. Applicants respectfully traverse this rejection. Claim 7 depends from claim 1 and is patentably distinguishable for at least the reasons provided above with respect to claim 1, as well as for additional reasons related to its own recitations.

All pending claims being allowable under all applicable Rules and Laws, and all other matters being fully compliant with all applicable Rules and Laws, Applicants respectfully request that the above captioned application be allowed to mature to a U.S. patent.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the Examiner's rejection under 35 USC § 102 and 103 in the Office Action dated May 4, 2006, no longer exists and should be withdrawn. The present Reply is in proper form, and none of the references teach or suggest Applicant's claimed invention. Accordingly, Applicants request timely allowance of the present application.

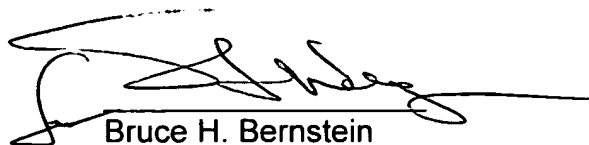
Applicants note that this Reply is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's rejections is made by the present Reply. All amendments to the claims which have been made in this Reply, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Commissioner determine that an extension of time is required in order to render this response timely and/or complete, a formal request for an extension of time, under 37 C.F.R. §1.136(a), is herewith made in an amount equal to the time period required to render this response timely and/or complete. The Commissioner is authorized to charge any required extension of time fee under 37 C.F.R. §1.17 to Deposit Account No. 19-0089.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

August 4, 2006  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

Respectfully Submitted,  
Masahiro HORA et al.



Bruce H. Bernstein  
Reg. No. 29,027

Steven Wegman  
Reg. No. 31,438